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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,077	10/04/2005	Ki Mun Kim	123051-05024312	8311

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EXAMINER

FARAGALLA, MICHAEL A

ART UNIT PAPER NUMBER

2617

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/526,077

Applicant(s)

KIM ET AL.

Examiner

Michael Faragalla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/04/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure statement

2. The information disclosure statement submitted on 10/04/2005 has been considered by the examiner and made of record in the application file.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims **1-9,12-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Park (Patent number: 2000-0000244)** in view of **Hong Park (publication number: 1999-0055454)**.

Consider **Claim 1**, Park clearly shows and discloses a method of providing an arbitrary sound (hereinafter read as alternative sound) to replace a conventional tone (hereinafter read as ringback tone) in a communication network comprising:

(a) A first step conducted by an HLR (Home Location Register), of furnishing an exchanger (hereinafter read as MSC), when a terminal is registered through the exchanger, with first information on whether an ordinary tone is to be replaced or not and second information informing a route to a sound providing means (hereinafter read

as IP) (page 4, lines 8-33; figure 2); (according to Park, the HLR 300 sends a routing request in order to connect the receiving mobile to the receiving MSC. Further, the SCP receives an analyzed information from the MSC 200. The analyzed information includes the MIN. Finally, the SCP performs a Seizeres request to the IP that fetches the alternative sound information).

(b) A second step, conducted by the exchanger, of requesting a trunk connection to the sound providing means, if the terminal is called by a caller based on the first and the second information (page 4, lines 22-33).

(c) A third step, conducted by the sound providing means, of determining a tone – replacing sound based on the received third information for the terminal, and providing the determined tone-replacing sound as a ringback tone to the caller through the exchanger which the trunk connection is made to (page 4, lines 28-35; page 5, lines 1-18; figure 2).

However, Park does not specifically show that the second step conducted by the exchanger, of requesting a trunk connection to the sound providing means, if the terminal is called by a caller, based on the first and the second information includes furnishing the sound providing means with a third information on call state.

In related art, Hong Park shows that the second step conducted by the exchanger, of requesting a trunk connection to the sound providing means, if the terminal is called by a caller, based on the first and the second information includes furnishing the sound providing means with a third information on call state (page 4, lines 17-24; page 5, lines 1-12).

Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to incorporate the teaching of Hong Park into the teaching of Park in order to provide a method for notifying various call states such that a subscriber may recognize a call state easily in a switching system (Hong Park, page 4, lines 17-19).

Consider **Claim 2**, Park clearly shows and discloses a method of providing an arbitrary sound (hereinafter read as alternative sound) to replace a conventional tone (hereinafter read as ringback tone) in a communication network comprising:

(a) A first step conducted by an HLR (Home Location Register), of furnishing an exchanger (hereinafter read as MSC), when a terminal is registered through the exchanger, with first information on whether an ordinary tone is to be replaced or not and second information informing a route to a sound providing means (hereinafter read as IP) (page 4, lines 8-33; figure 2); (according to Park, the HLR 300 sends a routing request in order to connect the receiving mobile to the receiving MSC. Further, the SCP receives an analyzed information from the MSC 200. The analyzed information includes the MIN. Finally, the SCP performs a Seizeres request to the IP that fetches the alternative sound information).

(b) A second step, conducted by the exchanger, of requesting a trunk connection to the sound providing means, if the terminal is called by a caller based on the first and the second information (page 4, lines 22-33).

(c) A third step, conducted by the sound providing means, of determining a tone – replacing sound based on the received third information for the terminal, and providing

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the determined tone-replacing sound as a ringback tone to the caller through the exchanger which the trunk connection is made to (page 4, lines 28-35; page 5, lines 1-18; figure 2).

(d) A fourth step, conducted by the exchanger, of requesting release of the first trunk connection to the sound providing means, if the terminal accepts the call from a caller (page 4, lines 22-33).

(e) A fifth step, conducted by the sound providing means, of determining a tone-replacing sound based on the received fourth information for the terminal, and providing the determined tone-replacing sound to the former caller through the exchanger which the second trunk connection is made to (page 4, lines 28-35; page 5, lines 1-18; figure 2).

However, Park does not specifically show that:

(a) The second step, conducted by the exchanger, of requesting a first trunk connection to the sound providing means, if the terminal is called by a latter caller under already-connected condition to a former caller, based on the first and the second information while providing the sound providing means with third information on call state.

(b) Providing the determined tone replacing sound as a ringback toe to the latter caller through the exchanger.

(c) The fourth step, conducted by the exchanger, of requesting release of the first trunk connection to the sound providing means, if the terminal accepts the call from the later caller, and requesting a second trunk connection to the sound providing means for the

connected former caller while providing the sound providing means with fourth information on call switched.

(d) Providing the determined tone-replacing sound as a call-waiting tone to the former caller through the exchanger, which the second trunk connection is made to.

In related art, Hong Park shows that:

(a) The second step, conducted by the exchanger, of requesting a first trunk connection to the sound providing means, if the terminal is called by a latter caller under already-connected condition to a former caller, based on the first and the second information while providing the sound providing means with third information on call state (page 4, lines 20-24; page 5, lines 1-8; table 1); (call states of receiving mobile are recorded and then displayed for the calling party according to table 1).

(b) Providing the determined tone replacing sound as a ringback toe to the latter caller through the exchanger (table 1; page 4, lines 20-24; page 5, lines 1-8).

(c) The fourth step, conducted by the exchanger, of requesting release of the first trunk connection to the sound providing means, if the terminal accepts the call from the later caller, and requesting a second trunk connection to the sound providing means for the connected former caller while providing the sound providing means with fourth information on call switched (table 1; page 4, lines 20-24; page 5, lines 1-8).

(d) Providing the determined tone-replacing sound as a call-waiting tone to the former caller through the exchanger, which the second trunk connection is made to (table 1); (according to Hong Park, messages or music are recorded and then displayed to a calling party to show the state of the receiving phone, which includes putting the second

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caller on hold, which means that there are to connections (trunks) that are released to the former and the latter callers).

Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to incorporate the teaching of Hong Park into the teaching of Park in order to provide a method for notifying various call states such that a subscriber may recognize a call state easily in a switching system (Hong Park, page 4, lines 17-19).

Consider **Claims 3 and 12**, Park as modified by Hong Park shows the method of claim 1 as well as the method of claim 2, but fails to specifically show that the third information is to indicate that the terminal is busy.

In related art, Hong Park shows that the third information is to indicate that the terminal is busy (table 1).

Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to incorporate the teaching of Hong Park into the teaching of Park in order to notify the calling party of the call state (Hong Park page 4, lines 20-23).

Consider **Claim 4**, Park as modified by Hong Park shows the method of claim 2, but fails to specifically show that the fourth information is to indicate that either of the callers is suspended to wait for call reconnection.

However, in related art, Hong Park shows that the fourth information is to indicate that either of the callers is suspended to wait for call **RECONNECTION** (table 1; third row

indicates that there is a message for the caller telling him/her to call again because there is no answer).

Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to incorporate the teaching of Hong Park into the teaching of Park in order to notify various call states associated with subscriber phone usage (Hong Park; page 9, lines 11-14).

Consider **Claims 5 and 13**, Park as modified by Hong Park shows the method of claim 1 as well as the method of claim 2, but fails to specifically show that the first information on whether an ordinary tone is to be replaced or not is set in the HLR based on specific key information received from the terminal.

However, , in related art, Hong Park shows that the first information on whether an ordinary tone is to be replaced or not is set in the HLR based on specific key information received from the terminal (page 14, lines 2-15).

Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to incorporate the teaching of Hong Park into the teaching of Park in order to notify various call states by voice messages instead of tones (Hong Park; abstract, lines 8-15).

Consider **Claims 6 and 14**, Park as modified by Hong Park shows the method of claim 1 as well as the method of claim 2, wherein the first and the second information are included in a response message to a location registration request message, the

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response message being sent from the HLR to the exchanger (page 4, lines 8-21; figure 2).

Consider **Claim 7**, Park as modified by Hong Park shows the method of claim 6, wherein the first information is written in a reserve field allocated in value-added service parameters of subscriber's profile (page 4, lines 22-30).

Consider **Claims 8 and 15**, Park as modified by Hong Park shows the method of claim 1 as well as the method of claim 2, wherein the sound providing means determines the tone-replacing sound based on who the caller is, which group the caller belongs to among several groups classified by the called (page 5, lines 12-18).

However, Park does not show that the sound providing means determines the tone-replacing sound based on calling time, and/or calling state.

In related art, Hong Park shows show that the sound providing means determines the tone-replacing sound based on calling time, and/or calling state (tables 1 and 2).

Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to incorporate the teaching of Hong Park into the teaching of Park in order to notify the calling party of the call state (Hong Park page 4, lines 20-23).

Consider **Claims 9 and 16**, Park as modified by Hong Park shows the method of claim 1 as well as the method of claim 2, wherein a message to request a trunk connection to

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the sound providing means includes called- and caller- identification (page 4, lines 22-27; page 5, lines 12-18).

7. Claims **10,11 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Park (Patent number: 2000-0000244)** in view of **Hong Park (publication number: 1999-0055454)** and further in view of **Chavez, Jr. et al (Patent number: 6,603,844)**.

Consider **Claims 10 and 17**, Park as modified by Hong Park shows the method of claim 1 as well as the method of claim 2, but fail to specifically show that the sound providing means changes a current tone-replacing sound specified for the called with another one through communication with a web server operating on internet protocol.

However, in related art, Chavez, Jr. et al show that the sound providing means changes a current tone-replacing sound specified for the called with another one through communication with a web server operating on internet protocol (abstract; column 2, lines 38-52).

Therefore it would have been obvious to a person skilled in the art at the time the invention was made to incorporate the teaching of , Chavez, Jr. et al into the teachings of Park and Hong Park in order to send an advertisement to a calling party instead of a normal ring back tones (abstract).

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Consider **Claim 11**, Park as modified by Hong Park shows the method of claim 10, but fail to specifically show that said another sound is one already stored in the sound providing means or received via the web server.

However, in related art, Chavez, Jr. et al show that the another sound is received via the web server (abstract; column 2, lines 38-52).

Therefore it would have been obvious to a person skilled in the art at the time the invention was made to incorporate the teaching of , Chavez, Jr. et al into the teachings of Park and Hong Park in order to send an advertisement to a calling party instead of a normal ring back tones (abstract).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) RING-BACK TONE SERVICE SYSTEM AND THE METHOD (WO 2005/004453).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Faragalla whose telephone number is (571) 270-1107. The examiner can normally be reached on Mon-Fri 7:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Faragalla
10/16/2006



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